



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,607	11/29/2005	Thomas Grafenauer	P28533	4105
7055	7590	12/15/2008	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			PLUMMER, ELIZABETH A	
			ART UNIT	PAPER NUMBER
			3635	
			NOTIFICATION DATE	DELIVERY MODE
			12/15/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com



Art Unit: 3635

### **DETAILED ACTION**

Applicant's amendments and arguments received 07/08/2008 have entered and considered. Claim 3 has been canceled. Claims 21-27 have been added. An examination of pending claims 1-2 and 4-27 is herein presented.

#### ***Election/Restrictions***

1. Newly submitted claims 25-27 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 1 is drawn to two resilient lips which extend from opposite side edges, and one lip extends upward and the other lip extends downward. Regarding claim 25, claim 25 has an insert wherein the resilient lip extends from the lower lip; in this case, the lips can be considered to extend from the same side. Regarding claims 26 and 27, both resilient lips extend downward/are directed toward the bottom side.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25-27 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3635

3. Claims 1, 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Haid (US Patent 4,599,841).

a. Regarding claim 1, Haid discloses a device for connecting and locking building boards comprising a top side and a bottom side, having a core made of wood material and provided with a groove on at least two opposite side edges, comprising an insert (5) intended for locking purposes, which can be inserted into the groove of one of the sides edges (Fig. 1,6), the boards being connected by substantially horizontal displacement toward one the other, wherein the insert is provided with one resilient lip extending upset from a first side directed toward the top side of the insert (top 8) and another resilient lip extending downward from a second side edge directed toward the bottom side of the insert (bottom 8).

b. Regarding claim 2, the one and another resilient lips are direction in opposite directions (left and right).

c. Regarding claim 5, the insert is plastic (column 3, lines 40-41).

4. Claims 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Meyerson (US Patent 5,086,599). Regarding claim 1, Meyerson discloses a device for connecting and locking building boards comprising a top side and a bottom side, having a core made of wood material and provided with a groove on at least two opposite sides, comprising an insert (40) intended for locking purposes, which insert can be inserted into the groove (Fig. 15,16) of one of the side edges, the boards being connected by substantially horizontal displacement toward the other, wherein the insert is provided with one resilient lip extending upward from a first side edge directed toward the top

Art Unit: 3635

side (see bottom of 40) and another resilient lip extending downward from a second side edge directed toward the bottom side of the insert (see top of 40).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 4-5, 7-12 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martensson (WO 00/20705) in view of Haid (US Patent 4,599,841).

a. Regarding claim 1, Martensson discloses a device for connecting and locking building boards (1) comprising a top side and a bottom side having core made of wood (page 1, line 6) material and provided with a groove (4) on at least two opposite side edges comprising an insert (10) intended for locking purposes, wherein the insert can be inserted into the groove (4) of one of the side edges, the boards being connected by substantially horizontal displacement one toward the other, wherein the insert is provide with two resilient lips (Fig. 7b, 7c, 7d) directed toward the top side or the bottom side. While Martensson discloses lips that can extend upward from a first die edge toward the top side of the insert (Fig. 7a,7b,7c) and lips that can extend downward and be directed toward the bottom side of the insert (Fig. 7d), Martensson disclose not disclose one embodiment wherein one resilient lip extends upward from a first side edge directed toward the top side of the insert and another resilient lip extends

Art Unit: 3635

downward from a second side edge directed toward the bottom side of the insert. However, it is notoriously well known in the art that inserts can have two resilient lips wherein one resilient lip extends upward from a first side edge directed toward the top side of the insert and another resilient lip extends downward from a second side edge directed toward the bottom side of the insert. For example, Haid teaches a device for connecting and locking building boards comprising a top side and a bottom side, having a core made of wood material and provided with a groove on at least two opposite side edges, comprising an insert (5) intended for locking purposes, which can be inserted into the groove of one of the sides edges (Fig. 1,6), the boards being connected by substantially horizontal displacement toward one the other, wherein the insert is provided with one resilient lip extending upset from a first side directed toward the top side of the insert (top 8) and another resilient lip extending downward from a second side edge directed toward the bottom side of the insert (bottom 8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Martensson to include one resilient lip extends upward from a first side edge directed toward the top side of the insert and another resilient lip extends downward from a second side edge directed toward the bottom side of the insert, such as taught by Haid, in order to make the insert more fully engage the grooves of the boards, creating a stronger connection.

b. Regarding claim 2, the one and another resilient lips directed in the opposite direction (Fig. 7b,7c,7d).

Art Unit: 3635

- c. Regarding claim 4, the resilient lip has a tip running obliquely to the top side and bottom sides, which tip, cooperates with an obliquely running edge (Fig. 7b,7c).
- d. Regarding claim 5, the insert is plastic (page 8).
- e. Regarding claim 7, the insert has a midway between the one and another resilient lips which rests on a shoulder, running parallel to the bottom side of the bottom lip of the groove (Fig. 7c).
- f. Regarding claim 8, when the building boards are mutually connected, the insert is essentially fully surrounded in its peripheral contour by the core material of the boards (Figs. 7a,7b,7c,7d).
- g. Regarding claim 9, the angle of inclination between the obliquely running edge measures between 90 and 135 degrees (Fig. 7b,7c).
- h. Regarding claims 10-12, Martensson in view of Haid discloses the invention as claimed except for specifying the thickness of the insert, the depth of penetration of the groove, or the flexural modulus of the plastic. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a structure within the claimed range, as it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or working ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.
- i. Regarding claim 14, the side edges of the insert taper outward (Fig. 7c).

Art Unit: 3635

j. Regarding claims 15 and 16, Martensson in view of Haid discloses the invention as claimed except for the side edges of the insert being rounded or conical. However, it would have been a matter of obvious design choice to form the side edges as rounded or running conically, as such a modification would have involved a mere change in shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1966).

k. Regarding claim 17, claim 17 is a product by process claim. The patentability of a product does not depend on its method of production. The insert is inserted into a groove (abstract), and the final product does not vary regardless of whether or not the insert is inserted at a factory site.

l. Regarding claims 18 and 19, the insert can be permanently connected by glue (page 7).

m. Regarding claim 20, the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In this case, the board (1) has grooves (4).

n. Regarding claim 24, when the building boards are mutually connected, the insert is essentially fully surrounded in its peripheral contour by the core material of the boards (Figs. 7a,7b,7c,7d), and an upper surface of the insert abuts a lip of



Art Unit: 3635

one of the building boards, the lip defining a groove that receives a tongue of another one of the building boards (Fig. 2a).

7. Claims 1 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martensson (US Patent 6,763,643) in view of Haid (US Patent 4,599,841).

a. Regarding claim 1, Martensson discloses a device for connecting and locking building boards (1) comprising a top side and a bottom side having core made of wood material and provided with a groove (4) on at least two opposite side edges comprising an insert (10) intended for locking purposes, wherein the insert can be inserted into the groove (4) of one of the side edges, the boards being connected by substantially horizontal displacement one toward the other, wherein the insert is provide with at least on resilient lip (Fig. 7b, 7c, 7d) directed toward the top side or the bottom side. While Martensson discloses lips that can extend upward from a first die edge toward the top side of the insert (Fig. 7a,7b,7c) and lips that can extend downward and be directed toward the bottom side of the insert (Fig. 7d), Martensson disclose not disclose one embodiment wherein one resilient lip extends upward from a first side edge directed toward the top side of the insert and another resilient lip extends downward from a second side edge directed toward the bottom side of the insert. However, it is notoriously well known in the art that inserts can have two resilient lips wherein one resilient lip extends upward from a first side edge directed toward the top side of the insert and another resilient lip extends downward from a second side edge directed toward the bottom side of the insert. For example, Haid teaches a

Art Unit: 3635

device for connecting and locking building boards comprising a top side and a bottom side, having a core made of wood material and provided with a groove on at least two opposite side edges, comprising an insert (5) intended for locking purposes, which can be inserted into the groove of one of the sides edges (Fig. 1,6), the boards being connected by substantially horizontal displacement toward one the other, wherein the insert is provided with one resilient lip extending upset from a first side directed toward the top side of the insert (top 8) and another resilient lip extending downward from a second side edge directed toward the bottom side of the insert (bottom 8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Martensson to include one resilient lip extends upward from a first side edge directed toward the top side of the insert and another resilient lip extends downward from a second side edge directed toward the bottom side of the insert, such as taught by Haid, in order to make the insert more fully engage the grooves of the boards, creating a stronger connection.

b. Regarding claim 13, the board is provided on one side with a tongue (22) pointing substantially in the transverse direction and on the other side edge with a groove (21) corresponding thereto (Fig. 8).

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martensson (WO 00/20705) in view of Haid (US Patent 4,599,841), as applied to claim 1 above, and in further in view of Riedi (US Patent 2,863,185). Regarding claim 6, Martensson in view of Haid discloses the invention as claimed except for the insert

Art Unit: 3635

having at least one cavity. However, it is notoriously well known in the art that inserts can comprise a cavity. For example, Riedi teaches an insert (10) for connecting and locking boards (16), wherein the insert comprises at least one cavity (Fig. 1,2,3,4) in order to more easily deform to fit inside the grooves of the board. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Martensson in view of Haid to include at least one cavity, such as taught by Riedi, in order to make the device easier to install.

9. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyerson (US Patent 5,086,599).

a. Regarding claim 21, the one resilient lip extends from the first side edge toward a center of the insert, and the another resilient lip extends from the second side edge toward the center of the insert. Meyerson does not disclose that the length of the one lip is greater than half the distance between the first side edge and the center of the insert and that the length of the another lip is greater than half the distance between the second side edge and the center of the insert. However, it would have been a matter of obvious design choice to make the lips a longer length such that the length is greater than half the distance between the side edges and the center of the insert, as such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Art Unit: 3635

c. Regarding claim 22, each of the one and another resilient lips includes a fixed end attached to a body of the insert (Fig. 15,16), a free end opposite the fixed end (Fig. 15,16) and an oblique tip at the free end, which, for locking, is instructed and arranged to cooperate with an obliquely running edge of the building board (Fig. 16).

d. Regarding claim 23, the insert comprises an upper surface step—shaped profile that allows the first resilient lip to be compressed and a lower surface step-shaped profile that allows the second resilient lip to be compressed (Fig. 15,16).

### ***Response to Arguments***

10. Applicant's arguments with respect to claims 1-2 and 4-27 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3635

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH A. PLUMMER whose telephone number is (571)272-2246. The examiner can normally be reached on Monday through Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeanette E Chapman/  
Primary Examiner, Art Unit 3633

Application/Control Number: 10/550,607

Page 13

Art Unit: 3635

/E. A. P./

Examiner, Art Unit 3635